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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------|-------------|----------------------|---------------------|------------------|
| 10/616,568 | 07/10/2003 | Richard E. Miller | R-113 | 2788 |
| 7590 | 07/28/2004 | | EXAMINER | |
| Richard Miller | | | STRIMBU, GREGORY J | |
| 329 Ahern St., Apt. 3 | | | | |
| Atlantic Beach, FL 32233 | | | ART UNIT | PAPER NUMBER |
| | | | 3634 | |

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------------|--------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/616,568 | MILLER, RICHARD E. |
| | Examiner Gregory J. Strimbu | Art Unit 3634 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-14, 19 and 20 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 and 15-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 July 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

It should first be noted that the applicant called the examiner requesting that the examiner examine this application, serial no. 10/616,568, early since it is a continuation-in-part of a parent application filed in 1997. Due to the early filing date of the parent application, the examiner agreed to examine this application as soon as possible and suggested changes to place the case into a condition for allowance on April 30, 2004. The examiner subsequently discussed the proposed changes with the applicant on several occasions and requested an answer regarding the proposed changes. However, as of the date of this Office action, the applicant has not been able to agree with the proposed changes.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

| | |
|-----------|----------------------|
| Group I | Figures 1-5 and 8-10 |
| Group II | Figures 6 and 7 |
| Group III | Figure 11 |
| Group IV | Figures 12-15 |
| Group V | Figure 16 |

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Richard E. Miller on April 29, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9 and 15-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-14, 19 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to because the applicant has failed to use the proper cross sectional shading when showing the invention with a cross sectional view. See MPEP 608.02. For example, the applicant shows the seal with a metal cross sectional shading in figure 5. It is suggested that the applicant use same cross sectional shading that is used in figures 2-4 throughout the drawings where appropriate. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because "the curved sheet member along the element" on line 3 is grammatically awkward and confusing. Additionally, the abstract is objected to because it does not describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Note that the applicant has failed to set forth the coiling or uncoiling of the sheet member with respect to the element. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: the status of the parent applications on page 1 requires updating. Note that 10/050,086 is now abandoned and that it is a continuation-in-part of 09/634,050.

Appropriate correction is required.

Claim Objections

Claim 15 is objected to because it includes more than one capital letter on line 6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-9 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "opposite attachment edges" on line 5 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. It appears that the sheet member is homogeneously formed with the wall. Therefore, the sheet member can have only one edge, i.e., its distal edge. Additionally, it is unclear which of the three edges of the sheet member the applicant is referring to. Recitations such as "a first surface" on line 2 of claim 2 render the claims indefinite because it is unclear if the applicant is referring to the first surface set forth above or is attempting to set forth another first surface in addition to the one set forth above. Recitations such as "said element" on line 1 of claim 7 render the claims indefinite because they lack antecedent basis. Recitations such as "so that . . . resume said passive condition" on lines 12-14 of claim 15 render the claims indefinite because it is unclear what the applicant is attempting to set forth.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kellner. Kellner discloses a rolling seal comprising a wall 1 generally in the form of a right circular cylinder, the wall being resiliently compressible, a resilient coiled sheet member 2 having opposite attachment edges with one of the attachment edges being attached to the wall, the sheet member being coiled about the wall, wherein the coiled sheet member is spaced from the wall, an extension member 3

Claim Rejections - 35 USC § 103

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner as applied to claims 1-4, 7 and 9 above, and further in view of Brown. Brown discloses, in figure 10, a seal having a wall 41e and an extension member 41f wherein the extension member is wedge shaped.

It would have been obvious to one of ordinary skill in the art to provide the extension member of Kellner with a shape, as taught by Brown, to enable the seal to better seal against slanted surfaces.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner as applied to claims 1-4, 7 and 9 above, and further in view of Naramore. Naramore discloses a seal having a stepped sheet member.'

It would have been obvious to one of ordinary skill in the art to provide Kellner with a stepped sheet member, as taught by Naramore, to more securely mount the seal to a surface.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner as applied to claims 1-4, 7 and 9 above, and further in view of Hast. Hast discloses a seal comprising a solid wall 1.

It would have been obvious to one of ordinary skill in the art to provide Kellner with a solid wall, as taught by Hast, to increase the strength of the wall.

Allowable Subject Matter

Claims 15-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a closure having first and second surfaces and a rolling seal comprising a resiliently compressible element generally in the form of a right circular cylinder, a coiled sheet member having an attachment edge attached to said element, said coiled sheet member being freely coiled about the element and space from the element when said seal is in a passive condition, an extension member attached to the sheet member, the extension member being attached to the first surface

of the closure so that relative motion between said first and second surfaces in a first direction causes contact with between the element and the second surface such that said element either is rolled away from said extension member and said sheet member is uncoiled relative to the passive condition or is rolled toward the extension member and the sheet member is coiled further about said element into an active condition creating a seal between the first and second surfaces, and further so that relative motion between the first and second surfaces in a direction opposite to said first direction releases said element and said sheet member will resume the passive condition. See lines 1-14 of claim 15.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wirs, Protzman, Cutting, Wendl et al., Hollenbaugh et al., Azzola, Hirtle et al., Frehse, Ternstrom, Poyton, Procton, Miller, German Patent Publication Nos. 900,006, 646,026 and 2,061,716 and French Patent Publication No. 611,951 are cited for disclosing a seal having a generally cylindrical body portion and an extension member. Howe and Hinzpeter et al. are cited for disclosing a seal having an extension member

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Strimbu
Primary Examiner
Art Unit 3634
July 26, 2004